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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,467	03/28/2005	Per Moller	1175/74121	8292

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT PAPER NUMBER

1775

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/529,467

Applicant(s)

MOLLER, PER

Examiner

Michael La Villa

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
2. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Regarding Claim 1, it is unclear what is meant by the phrases "selected to adsorb," "selected to reduce," and "selected to catalyze." It is unclear whether these various "selections" are planning steps or steps requiring actual achievement of the claimed action. For example, must the adsorbing metal oxide adsorb transition metal ions in the claimed process? An analogous rejection applies to the phrase "selected to catalyze" in Claim 12.
5. Regarding Claims 1 and 12, applicant requires that the claimed method is a pretreatment method for plating "by way of precipitation of a selected precipitation metal." It is unclear what is the relationship between this requirement and the claimed steps (a) through (c). Were a catalytic metal not selected to catalyze a subsequent precipitation, but nevertheless would do so, it is unclear whether the claimed process is performed. Were a catalytic metal selected to catalyze a subsequent precipitation, but nevertheless could not do so, it is unclear whether the claimed process is performed. In terms of materials encompassed by the claimed method, it is unclear what is the relationship

between the functional property of the "catalytic metal ion" and the planned, but not necessarily performed, precipitation of a selected precipitation metal.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
7. A person shall be entitled to a patent unless –
8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
9. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ejerer GB 1,401,600 for the reasons of record in the Office Action mailed on 13 March 2006.
10. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Cane USPN 5,648,125 for the reasons of record in the Office Action mailed on 13 March 2006.

Response to Amendment

11. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 13 March 2006. Rejection is withdrawn, but new rejections are presented above.
12. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Ejerer of the Office Action mailed on 13 March 2006. Applicant argues that Claim 1 is not taught and therefore claims dependent therefrom, such as Claims 13-16, cannot be taught either. The claimed product of Claims 13-16 is taught whether formed by the product-by-process limitations of

Claim 1 or by any other process. The rejection is predicated on the analysis of the implied compositional and structural properties of an article formed by the claimed method steps of Claim 1, even though the claimed product-by-process steps may not have been actually performed in Ejerer to achieve those implied compositional and structural properties. Rejection is maintained.

13. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Cane of the Office Action mailed on 13 March 2006. Applicant argues that Cane teaches an acid rinse that would be expected to remove the metal oxide. Cane refers to the effects of the acid rinse at col. 16, lines 6-42 and col. 28, lines 55-60. Cane explains that the permanganate treatment forms a manganese oxide layer covalently bonded to the substrate. Nowhere does the discussion explain that this layer is completely removed by the acid rinse. Where Cane refers to eliminating manganese deposits, it is unclear why this reference should be construed to refer to eliminating the covalently bonded manganese oxide layers. With respect to Claims 13-16, analogous remarks to those provided in responding to applicant's traversal of the rejection of Ejerer are applicable. Moreover, Claim 1 does not demand the presence of adsorbed metal oxide at the conclusion of the pretreatment method. Rejections are maintained.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael La Villa
21 November 2006


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER